

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENICHI MIYAZAKI

Appeal No. 2006-0474
Application No. 09/386,000

ON BRIEF

Before FRANKFORT, BAHR and NAPPI, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under 37 CFR § 41.50(a) for appropriate action with regard to the items indicated below.¹

¹ The oral hearing set for 9:00 AM on Tuesday, March 7, 2006 has been vacated. Appellant's counsel was informed of that action by BPAI Programs and Resources Administrator Craig Feinberg on February 28, 2006.

On October 11, 2005 appellant filed a reply brief including 41 pages of argument and comments concerning each of the nine rejections maintained by the examiner on appeal and separately addressing the examiner's various positions in the answer with regard to nearly all of the thirteen claims on appeal, eight of which are independent claims. The reply brief also included attached evidence relied upon by appellant in the arguments set forth on pages 30-35 of the reply brief. Our review of the record would appear to show that the reply brief represents appellant's first opportunity to respond to the full details of many of the examiner's rejections on appeal.

In response to the reply brief, the examiner sent out a communication (mailed November 4, 2005) informing appellant that the reply brief had been "entered and considered" and that the application was being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Our problem is that the examiner's *pro forma* response is woefully inadequate in this particular case, since it fails to provide us with his views concerning the numerous and specific arguments presented by appellant in the 41 pages of the reply

brief. Nor does the examiner address the new evidence in the form of the User Manuel for the OCE 9400 Printer/Copier attached to the reply brief. As we noted above, appellant has specifically relied upon that evidence in arguments presented in the reply brief (pages 30-35). In addition, it appears that the examiner has ignored the argument bridging pages 29-30 of the reply brief asserting that the Digital ES printout dated July 2004, relied upon to reject claims 1, 3, 5, 6, 13, 17, 18, 26 and 31 under 35 U.S.C. § 102(b), is not prior art to the present application which was filed on August 30, 1999. On its face, it would seem that appellant makes a good point.

Thus, we REMAND the application to the examiner for a full and complete response on the record to the many arguments and issues raised by appellant in the reply brief. A supplemental examiner's answer responsive to the above-noted reply brief would appear to be necessary. It follows that appellant should have an opportunity to respond to any such supplemental answer by way of a further reply brief or via other action as provided in 37 CFR § 41.50(a)(2).

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Rev. 3, August 2005.

REMANDED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

Jennifer D. Bahr

JENNIFER D. BAHR
Administrative Patent Judge

Robert E. Nappi

ROBERT E. NAPPI
Administrative Patent Judge

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